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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,665	11/17/2000	Michael William Urbanski	057234-0101	4398

22428 7590 08/13/2008  
FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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08/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/714,665	<b>Applicant(s)</b> URBANSKI ET AL.	
	<b>Examiner</b> Donald L. Champagne	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4,5,8,14,17,19,23,25,26,29,34,35,40-55 and 57-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4,5,8,14,17,19,23,25,26,29,34,35,40-55 and 57-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 April 2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is dependent on now-cancelled claim 32.

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 4, 8, 14, 17, 19, 23, 25, 26, 29, 34, 35, 40-43, 46-50, 53, 54, 60, 63 and 66 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLorme et al. (US005948040A).

7. DeLorme et al. teaches (Independent claims 40 and 47 and 54) a computer implemented method, computer readable storage medium containing said method and a system of communicating information concerning a target location for which a user seeks information from a server to a user's computing/communication device communicatively connected to said server on a network, the method comprising the steps of:

determining a said target location (*the Palisade restaurant* among restaurants along a user-selected route in Seattle, Washington, col. 49 line 60 to col. 50 line 8) specified by said computing/communication device independently of a current physical location of said computing/communication unit and said server;

providing contextual information (the *selected types or categories of POI's*, col. 50 line 2, and a *user selected area*, col. 50 lines 5-6) about said user or said computing/communication device to said server;

at said server retrieving from a database at least one of a plurality of categories of sponsored information (col. 28 lines 1-6 and 56-64, and col. 47 lines 45-56) provided by exclusive sponsors (whoever bears the cost of the "15 % discount" promotion in dialog box **595**, Fig. 5D and col. 50 lines 23-31)<sup>1</sup> for said target location; and

delivering said sponsored information (the dialog box **595**) to said computing/communications device (a *PDA*, col. 14 line 66 to col. 15 line 8 and 72 line 62 to col. 73 line 5) over said network (the *Internet*, col. 8 lines 1-3), wherein said sponsored information is determined in part based on said provided contextual information (i.e., the Palisades restaurant and its dialog box **595** were selected as a result of the user's selection of *Restaurants* as a POI in this *user-selected area*).

8. "Contextual information" was interpreted as any information used to target/determine ads (sponsored information). See para. 20 below.

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<sup>1</sup> A "sponsor" is "a person that pays for a project or activity", Merriam-Webster's Collegiate® Dictionary, 10<sup>th</sup> ed.

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9. DeLorme et al. teaches at the citations given above claims 2, 4, 8, 14, 17, 19, 23, 25, 26, 29, 34 (where the user selections read on “characteristics of the user”), 35, 41, 42, 48, 49, 60, 63, and 66.
10. DeLorme et al. teaches claims 43 and 50 (col. 22 lines 7-11) and claims 46 and 53 (col. 21 lines 40-48).
11. Claims 44, 45, 51, 52, 58, 59, 61, 62, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (US005948040A).
12. DeLorme et al. does not teach (claims 44 and 51) delivering sponsored information for a specific period of time. Advertising was commonly sold for a specific period of time at the time of the instant invention. Official notice of this common knowledge or well-known in the art statement was taken in the Office action mailed on 29 June 2007 (Para. 9). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner’s assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.) Claims 45 and 52 do not add effective limitations because the application does not provide a *clear definition* (MPEP § 2111.01) of “sub-division”. Any division, down to that including only of one sponsor (e.g., *the Palisade restaurant*, para. 7 above) reads on claims 45 and 52.
13. DeLorme et al. does not teach (claims 58, 59, 61, 62, 64 and 65) that the contextual information is either demographic information related to the user or identification information related to said computing/communication device. “Contextual information” is interpreted as ad targeting information (para. 20 below). Official notice is taken that it was well known at the time of the invention to target ads to users by their demography or by cookies placed on their computing/communication device, said cookies reading on “identification information related to said computing/communication device”. Demography is one of the oldest bases for advertising (e.g., advertising cosmetics in women’s magazines). Cookies have been used for more than a decade to store user preferences, which is a basis for targeting.
14. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (US006664922B1) in view of Feezell et al. (US006253189B1). DeLorme et al. does not teach an auction for a specific time period. Feezell teaches an auction for a specific time period (Abstract). Because Feezell teaches that non-auction methods have many

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deficiencies (col. 1 line 18 to col. 2 line 39), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Feezell to those of DeLorme et al.

15. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01): “an existing exclusive sponsor in a respective category of information”. In the sense used in the patent law (35 USC 101), a characteristic of the bidder is not functional because said characteristic is neither “tied to a particular apparatus” nor “operates to change materials to ‘a different state or thing’” (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).
16. Neither reference teaches that another bidder is permitted to match the highest bid. It was common, at the time of the instant invention, for vendors to offer special terms to those customers with whom they have a relationship. Official notice of this common knowledge or well-known in the art statement was taken in the Office action mailed on 29 June 2007 (Para. 12). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner’s assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.). The traverse filed on 18 April 2008 (p. 11) is not seasonal.
17. Claim 57 is rejected under 35 U.S.C. 102(a) as being anticipated by “Foreclosure Search”, a website published on 25 January 1999.<sup>2</sup> Foreclosure Search teaches a computer implemented method of communicating residential real estate (*number of bedrooms and baths*) foreclosure information concerning a target location (*zip code*) for which a user seeks residential real estate foreclosure information from a server to a user's computing/communication device communicatively connected to said server on a network, the method comprising the steps of:
  - determining a said geographical region (*zip code*) specified by said computing/communication device independently of a current physical location of said computing/communication unit and said server;
  - at said server retrieving from a database at least one of a plurality of categories of real estate professional contact information (the *Contact Us* button on the webpage) related to residential real estate foreclosure provided by exclusive real estate professionals (the

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operators of the website) participating in residential real estate foreclosure transactions for said geographical region; and

delivering said sponsored information related to residential real estate foreclosure to said computing/communications device over said network.

18. Applicant is hereby put on notice that the claim is replete with non-functional descriptive material, to which the examiner is not required to give patentable weight (MPEP § 2106.01). The non-functional descriptive material includes, “real estate professional contact information related to residential real estate foreclosure” and “provided by exclusive real estate professionals participating in residential real estate foreclosure transactions for said geographical region”. In the sense used in the patent law (35 USC 101), said contact and source information merely taken from a database is not functional because it is neither “tied to a particular apparatus” nor “operates to change materials to ‘a different state or thing’” (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).

### ***Response to Arguments***

19. Applicant's arguments filed with an amendment on 18 April 2008 have been fully considered but they are not persuasive.

20. Applicant argues (p. 10),

“In contrast, claims 40, 47 and 54 disclose that contextual information about the user or computing/communication device is provided to the server in addition to determining a target location.” (Applicant's 18 April 2008 filing, p. 10, emphasis added.)

Applicant's point is not entirely clear. It is fact that the claims are now limited to both “providing contextual information” and “determining a said target location”, but there is nothing in the claims to preclude the use of the provided “contextual information” for “determining a said target location”. Furthermore, the spec. defines “contextual information” by example as “a subject matter of interest to the user” (spec. p. 12 line 8). That could be most anything, and surely includes the *Points of Interest* selected by the user in DeLorme. DeLorme clearly teaches (col. 49 line 65 to col. 50 line 8) that said contextual information/*POI* is used to determine a said target location (the *Palisade restaurant*).

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<sup>2</sup> Squires (St. Petersburg Times, 23 August 1998) suggests the *Foreclosure Search* website was

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21. Concerning the amendment of claim 57, this Office action has been made non-final because the examiner said (in the advisory action mailed on 1 May 2008) the amendment would overcome the last basis of rejection, but the same basis of rejection has now been maintained for claim 57.
22. More broadly, the examiner has reviewed the prosecution history and the specification for some basis for allowance, and frankly found none. However, the application is qualified to be interviewed, so the examiner would be pleased to interview the case or otherwise consider and comment on an amendment thought to have merit by the applicant.

### ***Conclusion***

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
24. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
26. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov).



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At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

9 August 2008

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688